

REMARKS/ARGUMENTS

Claims 1-12 and 14-15 are pending in this application. Claim 13 has been canceled without prejudice. Claims 1, 2, 5 and 7 have been currently amended. Claims 1 and 7 are independent claims. Support for the amendment may be found throughout the specification and drawings.

Claim Objections

Claim 13 was “objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim” (Office Action, page 2). Claim 13 has been canceled without prejudice.

Claim Rejections – 35 USC § 112

Claims 7-15 were “rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement (Office Action, page 2). The Patent Office has alleged “[a]s to claim 7, at lines 21-22, examiner does not see where applicant disclosed the step of ‘disallowing up-level clients from interacting with down-level server[s].’ It is only disclosed on summary of the invention and the conclusion, not how it is implemented” (Office Action, page 3, top 4 lines). Applicant respectfully disagrees.

First, paragraph [0034] at page 11 of Specification cites “[a]llow down-level clients to interact with up-level servers, but disallow up-level clients from interacting with down-level servers” and thus supports “disallowing up-level clients from interacting with down-level servers,” as recited in Claim 7.

Moreover, MPEP 2164.01 recites,

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even

though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.") (emphasis added).

Applicant herein respectfully submits that Claims 7-12 and 14-15 are enabled since "disallowing up-level clients from interacting with down-level servers" can be implemented by any person skilled in the art *without undue experimentation*.

Claims 5-15 were "rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (Office Action, page 3). Applicant has currently amended Claims 5 and 7. Applicant respectfully reminds the Patent Office that Claims 5-12 and 14-15 are specifically supported by paragraphs [0025] through [0036] of Specification.

Claim Rejections – 35 USC § 102

Claims 1-2 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lam et al. ("Lam", U.S. Patent Number 5,926,636). Applicant respectfully traverses this rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claim 1 recites "a sender and a receiver with dissimilar data

structure definitions ... prefixing an encoded data structure with a length value that reflects a size of the encoded data structure, the encoded data structure being transmitted from the sender to the receiver” (emphasis added). Applicant respectfully submits that Lam fails to teach, disclose, or suggest the foregoing element, as recited in Claim 1. Therefore, the rejections should be withdrawn, and Claim 1 should be allowed.

Claim 2 depends from Claim 1 and is therefore allowable due to its dependence upon Claim 1.

Claim Rejections – 35 USC § 103(a)

Claims 3-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lam in view of Hammond (“Hammond”, U.S. Patent Number 6,556,220). Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lam in view of Boutcher (“Boutcher”, U.S. Patent Number 6,493,768) and further in view of the admitted prior art (APA) pages 1-4. Claims 7-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lam in view of Hammond, further in view of Boutcher, and further in view of APA pages 1-4. Applicant respectfully traverses this rejection.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As indicated in the foregoing *Claim Rejections – 35 USC § 102* section, Lam fails to teach, disclose, or suggest “a sender and a receiver with dissimilar data structure definitions ... prefixing an encoded data structure with a length value that reflects a size of the encoded data structure, the encoded data structure being transmitted from the sender to the receiver” (emphasis added), as claimed in Claim 1. Furthermore, Hammond, Boutcher, and APA also fail to teach, disclose, or suggest

the above-indicated claim element. Thus, independent Claim 1 is nonobvious under 35 U.S.C. § 103.

Claims 3-6 depend from Claim 1, and are therefore nonobvious due to their dependence. Thus, the rejection should be withdrawn, and Claims 3-6 should be allowed.

For the similar rationale as applied to Claims 1-6, Claim 7 should be allowed. Claims 8-12 and 14-15 depend from Claim 7, and are therefore allowable due to their dependence.

Furthermore, as the Examiner is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (emphasis added) *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In the present application, the Examiner has selected portions from four references (i.e., Lam, Hammond, Boucher and APA) to arrive at the present invention, in which, none of the references supply the motivation for the additional reference as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness for

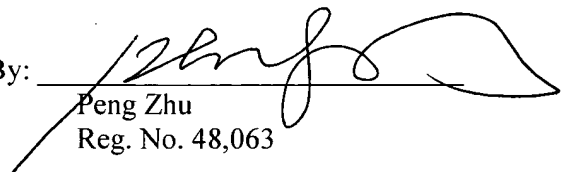
Claims 3-6, 7-12 and 14-15 has not been established. Therefore, Claims 3-6, 7-12 and 14-15 should be allowed.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of
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